

REMARKS

Claims 1-15 and 17-24 have been amended. Claims 1-24 remain for further consideration. No new matter has been added.

The objections and rejections shall be taken up in the order presented in the Official Action.

1. Acknowledgement that claims 1-24 are pending before the Office is correct.

2-3. Claims 1-2, 5-19 and 23-24 currently stand rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of the subject matter disclosed in U.S. Patent 6,298,305 to Kabada et al (hereinafter "Kabada") combined with the subject matter disclosed in U.S. Patent 6,334,089 to Hessing (hereinafter "Hessing").

Claim 1 recites a navigation system for use in a motor vehicle. The navigation system recited in amended claim 1 includes, inter alia:

- “a first non-volatile memory unit that stores a basic navigation database including road map information;

- a communication unit that receives supplemental navigation data including digital road map information, and provides received supplemental navigation data; and

- a second non-volatile memory unit that receives and stores the received supplemental navigation data;

- a navigation computer that receives start position data and the received destination position data, and computes driving directions between the starting position and the destination position using information from the basic navigation database and the received supplemental navigation data; and” (cl. 1, emphasis added).

The claimed navigation system includes a first non-volatile memory unit and second non-volatile memory unit that store navigation data. In the previous Official Action it was recognized that

Kabada fails to disclose first and second memory units (see Official Action dated April 8, 2004, pg. 2). In the current Official Action it is recognized that Kabada does not disclose a communication unit that receives supplemental navigation data (Official Action, pg. 2). The current Official Action alleges “[h]owever, Hessing discloses a communication unit that receives the supplemental navigation data including detailed information of digital road maps, and provides receives supplemental navigation data (see at least columns 1-2, lines 53-58; and columns 3-4, lines 48-34), a second non-volatile memory unit that receives and stores received supplemental navigation data, and a navigation computer receives supplemental navigation data (see at least columns 5-6, lines 35-4).” (Official Action, pgs. 2-3). It is further alleged in the Official Action that a skilled person would have modified Kabada by combining a communication unit that receives supplemental navigation data, and a second non-volatile memory to retain the data content when power is lost or turned off and receives and stores received supplemental navigation data to provide detailed route navigation to the driver. (see Official Action, pg. 3). However, it is respectfully submitted that a fair and reading of Kabada and Hessing reveals that this proposed combination is based upon an overly broad and incorrect reading of these references. We shall now discuss why this proposed combination is improper.

First, there is no teaching of “a communication unit that receives supplemental navigation data including digital road map information, and provides received supplemental navigation data;” (cl. 1). Hessing neither discloses nor suggests a communication unit that receives the supplemental navigation information. Hessing merely discloses a system in which all the navigation information is sent from the central server to the vehicle based navigation system in a piecewise manner. That is, the information received in Hessing is not supplemental – it is the along navigation information there is. Specifically, Hessing states “[t]he route 16 is

transmitted to the vehicle piecewise by means of the communication link 14 considering the traffic information 18 and the map 10." (col. 3, lines 58-61). Hessing also states "[t]he powerful processor of the central server 12 performs the comparatively difficult calculation of the route 16 and its continuous updating, even after the start of the journey from the starting point A. ... The navigation system only detects the autonomous intermediate destinations at the transitions points, that are not known to the operator, since they are subordinated to the reaching of the final destination B." (col. 5, lines 1-13). Hence, a fair and proper reading of Hessing reveals that this prior art reference merely discloses that **all** the route information for the vehicle is acquired and stored in the central server, and transmitted to the vehicle-based navigation system, not supplemental information.

The combined teachings of Kabada and Hessing neither disclose nor suggest a navigation system that includes a communication unit that receives supplemental navigation data, along with a navigation computer that receives start position data and received destination position data, and computes driving direction between the starting position and the destination position using information from a basic navigation database and the received supplemental navigation data. In addition, Hessing neither discloses nor suggests the use of a second non-volatile memory unit that receives and stores the received supplemental navigation data. In fact, a fair and proper reading of Hessing reveals that this reference teaches reducing the amount of memory located in the vehicle navigation system. Significantly, Hessing states that the piecewise transmission of route information from the central server to the vehicle-based navigation system allows the system of Hessing to reduce the amount of memory required. For example, see col. 2, lines 30-34; col. 2, lines 59-64; col. 4, lines 21-25; col. 4, lines 49-50; and col. 5, lines 59-63 of Hessing. Therefore, Hessing actually teaches using a system that is architected in order *to reduce the*

amount of memory required in the vehicle-based navigation system. Therefore, it is respectfully submitted that a skilled person would not have been motivated to add a second non-volatile memory unit to Kabada based upon the teachings of Hessing, since Hessing's teaching is to reduce the amount of memory located in the vehicle-based navigation system.

In addition, Hessing expressly teaches that “[t]he navigation system only detects the autonomous intermediate destinations at the transition points, that are not known to the operator, since they are subordinated to the reaching of the final destination B.” (col. 5, lines 10-13). Hessing's use of such a simplistic navigation system and its stated objective of using as small a memory on board the navigation system as possible reveals that Hessing teaches away from the computing in the navigation computer as set forth in claim 1.

Therefore, for any one of the foregoing reasons, even if Kadaba and Nimura were properly combinable the resultant combination stills fails to disclose or suggest a number of features of the claimed invention.

In addition, it is respectfully submitted that a prima facie case of obviousness has not been presented. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). “Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, [t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), citing In re

Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, “[w]hen the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why the combination of the reference teachings is proper.” Ex parte Stone, 2 U.S.P.Q.2d 1788, 1790 (Bd.App. & Int’f 1986) (emphasis added).

As noted above, it is fundamental that obviousness can not be established absent some teaching to combine the references, or a suggestion or incentive supporting the combination of references. See In re Geiger, at 1278 (Fed. Cir. 1987). In the instant case the Official Action is lacking the necessary factual, non-conclusionary explanation why the combination of the Kadaba and Hessing is proper. Hence, it is respectfully submitted that a prima facie case of obviousness has not been presented since there is no proper teaching, suggestion or incentive that would lead one of ordinary skill in the art to modify Kadaba based upon the teachings of Hessing to create the claimed invention.

Claim 23 recites a method that includes:

“storing in a first non-volatile memory unit connected to the navigation computer, a basic database that includes digital road map information, which is needed to calculate the driving route;

receiving data supplementary to the basic database, such as detailed information of digital road maps, over a network connection to a communication unit that is connected to the navigation computer; and

storing the received supplementary data in a second non-volatile memory unit that is connected to the navigation computer.” (cl. 23).

Significantly, this method involves storing navigation related data in first and second non-volatile memory units. Accordingly, it is respectfully submitted that claim 23 is patentable for at least all the same reasons as claim 1.

Claim 24 recites a navigation system for use in a motor vehicle that receives starting position data and destination position data and computes driving directions between the starting and destination positions. The navigation system includes, inter alia:

“a first non-volatile memory unit that stores a basic navigation database including road map information;

an RF receiver that receives supplemental navigation data including digital road maps, and provides received supplemental navigation data;

a second non-volatile memory unit that receives and stores the received supplemental navigation data;

means for receiving for computing driving directions between the starting position and the destination position using information from the basic navigation database and the received supplemental navigation data; and” (emphasis added, claim 24).

It is respectfully submitted that claim 24 is patentable for at least all the same reasons as claim 1.

4. Claim 3 currently stands rejected under 35 U.S.C. §103(a) in view of the combined subject matter disclosed in Kabada, Hessing and U.S. Patent 6,1287,969 to Van Roekel (hereinafter “Van Roekel”).

It is respectfully submitted that this rejection is now moot, since claim 1 is patentable for at least the reasons set forth above.

5. Claim 4 currently stands rejected under 35 U.S.C. §103(a) in view of the combined subject matter disclosed in Kabada, Hessing and U.S. Patent 6,366,622 to Brown et al (hereinafter “Brown”).

It is respectfully submitted that this rejection is now moot, since claim 1 is patentable for at least the reasons set forth above.

For all the foregoing reasons, reconsideration and allowance of claims 1-24 is respectfully requested.

If a telephone interview could assist in the prosecution of this application, please call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Patrick O'Shea". The signature is written in dark ink and is positioned above a horizontal line.

Patrick J. O'Shea
Reg. No. 35,305
O'Shea, Getz & Kosakowski, P.C.
1500 Main Street, Suite 912
Springfield, MA 01115
(413) 731-3100, Ext. 102